

Application No. 09/436,455
Amendment Dated October 6, 2005
Reply to Office Action mailed April 6, 2004

REMARKS

Claims 1-13, 18-60, 64-75, and 79-94, and 96 are currently pending. Claim 96 is newly added. Support for this claim may be found in Figure 5M of the application as well as the accompanying text. Applicant believes that no new matter is introduced by the amendment.

35 U.S.C. §103 - I

The Office Action rejects claims 1-13, 18-52, 54-74, and 79-94 under 35 U.S.C. §103(a) as being unpatentable over Farley et al. (U.S. Patent no. 6,152,899) in combination with Burnside et al. (U.S. Patent No. 6,071,281) and Jackson (U.S. Patent no. 5,846,238). Applicant disagrees with the rejections set forth in the previous Office Action.

Failure to Establish a Proper Prima Facie Case of Obviousness

First, applicant requests clarification regard to the Office Action's statement that “[t]he temperature sensor in the middle of leg 26 is considered inside same portions of the solder contacting are lead on the other and electrode are considered separate attachments. . . .” Applicant disagrees that this citation to Farley teaches or suggests the elements of applicant's claim. The leads of Farley are clearly shown in Figures 9-11 as being joined to a leg as a pair. To assert that these leads are separately joined is an unreasonable reading of the Farley disclosure.

Furthermore, the Office Action fails to establish a proper prima facie case of obviousness with regards to the combination of Farley and Jackson – especially when the suggested modification of Farley is to use a wire actuator of Jackson to alter the shape of any working element while conducting energy to the working element.

It is well established that the fact that reference can be combined is not sufficient to establish prima facie obviousness. There must be some suggestion as to the desirability of the combination. Moreover, it is not enough to state that the modification would be well within the ordinary skill of the art. There must be some objective reason to combine the references.

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This proposed modification of Farley to use a wire actuator of Jackson to alter the shape of any working element while conducting energy to the working element will render Farley unsuitable for its expressly disclosed purpose. The expansion mechanism of Farley is taught for the specific purpose of establishing a definite effective diameter of the catheter. Farley teaches a slidable outer tube 52 that when moved towards the working end 24 of the device causes the electrodes 22 to urge radially outward. (See Farley, e.g., col. 8, line 58 to col. 9, 32) Moreover, Farley teaches that an inner stop tube 54 is connected to the outer tube 52, such that the inner stop tube interacts with a stop surface 56 to limit the amount of expansion of the arms 26. Farley further teaches that maintaining a particular diameter of the electrodes is important because the treatment would shrink the veins further if it were not for the effective diameter of the catheter. (See Farley e.g., col. 9, lines 33-45.),

Simply replacing the expansion mechanism of Farley with a wire actuator of Jackson significantly goes against the purpose of the Farley device.

The Office Action fails to provide any motivation as to why one would modify Farley to use the wire actuator of Jackson. As noted above, there must be some reason as to why one would be motivated to make the proposed combination.

Applicant Requests Clarification of the Citation to Jackson

Apart from the above, applicant believes that Jackson actually fails to teach the elements suggested by the Office Action. Applicant requests clarification for the Office Action's assertion that "Jackson et al teach the use of a wire actuator, which alters the shape for the working element and also conducts energy to the working element." Applicant is unable to find in Jackson, any teaching in which the wire is configured to move an expandable portion between a first and second states and the wire is also configured to provide current to energy transfer elements. The Office Action provides no citation for this requirement.

Instead, Jackson teaches, on col. 12, lines 6-17, "the steering mechanism 54 includes a rotating cam wheel 56 coupled to an external steering lever 58 carried by the handle 18. The cam wheel 56 holds the proximal ends of right and left steering wires 60. The wires 60 pass with the ablation energy signal wires 26 through the catheter tube 12

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and connect to the left and right sides of a resilient bendable wire or leaf spring 62 adjacent the distal tube end 16 (see FIG. 12)." Clearly, Jackson describes separate steering wires and energy wires.

In the absence of clarification, applicant respectfully requests withdrawal of the rejection of claims 1-13, 18-52, 54-74, and 79-94 under 35 U.S.C. §103(a). As discussed above, the Office Action fails to establish a proper *prima facie* case of obviousness.

35 U.S.C. §103 - II

The Office Action rejects claims 53 and 95 under 35 U.S.C. §103(a) as being unpatentable over Farley et al. (U.S. Patent no. 6,152,899) in combination with Burnside et al. (U.S. Patent No. 6,071,281) and Jackson (U.S. Patent no. 5,846,238) and further in combination with Fischell et al. Applicant disagrees with this rejection.

Applicant has cancelled claim 95.

As noted above, the Office Action fails to establish a proper *prima facie* case. The addition of Fischell does nothing to remedy this defect.

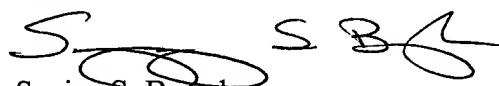
In view of the above, applicant requests withdrawal of this rejection.

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SUMMARY

Applicant believes all outstanding issue raised in the previous Office Action are addressed herein and that the claims are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (650) 242-4212.

Respectfully submitted,


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